

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Volker Deichmann  
Appl. No.: 10/019,329  
Conf. No.: 6261  
Filed: May 9, 2002  
Title: MOBILE PHONE WITH EXPANDED TELEPHONE DIRECTORY  
Art Unit: 2682  
Examiner: Tuan A. Tran  
Docket No.: 112740-372

Director of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This request is submitted in response to the Final Office Action dated October 20, 2005, and Advisory Action dated February 23, 2006. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

**Remarks** begin on page 2 of this paper.

### **REMARKS**

Claims 9-16 are pending in the present application. Claim 9 is the focus of this request.

Claims 9-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Holmstrom et al.* (WO 98/30053) in view of *Iwata et al.* (US Patent 6,009,338). Applicants submit the rejection is improper and should be reversed by this board.

Specifically, the cited art, alone or in combination, does not disclose “each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory is assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry” (emphasis added) as recited in claim 9.

The present claims address the internal data format of a SIM/nonvolatile memory configuration for storing telephone directory entries, where the GSM standard requires that a telephone directory entry be composed of a sequence of numbers (telephone number) and an associated sequence of alphanumeric characters (name). The same format is also used for telephone directory entries that are located in the nonvolatile memory. Under the standard, the number of attributes or features of a telephone directory entry (i.e., a telephone number or a name) is limited to two. Because of this limitation in attributes for telephone entries of an SIM card, flexible use of the telephone directory of a mobile phone (for example, the grouping of telephone numbers according to certain properties such as “work” or “personal”), is needed. Accordingly, claim 9 recites a telephone directory stored in a SIM card and another directory (if there is more than one), stored in non-volatile memory, where the telephone directory has its attributes prescribed by the SIM card. Claim 9 further recites at least one database stored in non-volatile memory that corresponds to a respective telephone directory, where each database has a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry. Accordingly, the format of the number of attributes which has been previously prescribed by the SIM card can be expanded via the “additional” attributes (such as grouping telephone numbers according to certain properties such as “work” or “personal”).

In contrast, *Holmstrom* does not teach an electronic data base assigned to the telephone directory in the SIM card in order to expand the prescribed structure of the telephone directory in the SIM card with respect to the structure of the telephone directory entries. This has been conceded in the Final Office Action dated October 20, 2005 (see page 2, paragraph 1)

However, *Iwata* fails to solve the deficiencies of *Holmstrom*, discussed above. *Iwata* discloses a mobile phone providing an address book where the user is provided with a list of names for an overview of certain address book entries according to a chosen index, wherein by double touching one of the list entries a corresponding address to this entry is scrolled and displayed (col. 14, line 4 – col. 15, line 13; see FIGs. 6 and 7). This configuration in *Iwata* merely discloses a scrolling function for locating stored names within an address book through their alphabetical order (A-Z) or their Japanese/English phonetic equivalent (“KA,” SA,” “TA,” etc.) (col. 14, lines 26-42). Thus, the display in *Iwata* is directed towards the same attribute (i.e., name), and does not provide for any additional attributes. *Iwata* also does not disclose a database being respectively assigned to one of the at least one electronic telephone directory as required in the present claims. Furthermore, *Iwata* is completely silent regarding the memory structure and does not disclose the use of SIM cards, instead disclosing that lists are stored within RAM memory 25 (col. 13, lines 19-21; col. 18, lines 9-20; FIG. 30 – col. 26, lines 29-48). As such, the reference does not disclose at least one data base stored in a non-volatile memory, wherein the at least one database is assigned to one specific electronic telephone directory to expand the telephone book structure.

Applicant submits that there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine *Holmstrom* with *Iwata* in the manner suggested in the Office Action. The Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). In making this determination, the question is not whether the differences between the prior art and the claims themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983)(emphasis added). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious

subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

The disclosure in *Holmstrom* is directed to a mobile communication unit, where the phone book is adapted to enable users to effect multiple users at the same time via the phone book to execute multiple functions (i.e. call, erase, store) and establish things like conference calls through a sequential "pick and execute" function (page 1, line 23 - page 2, line 3; page 4 to page 5, line 9). There is nothing in the disclosure of *Holmstrom* that teaches or suggests the modification of the phone book to provide additional attributes via supplementary databases. *Iwata* discloses mobile information terminal equipment which also functions as an electronic note, word processor, or personal computer, where the address book is integrates into a RAM memory of a PDA-type architecture (col. 1, lines 36-65; FIG. 6 and 7). The aforementioned name selection of *Iwata* is clearly disclosed as being embodied particularly for a touch-screen interface, where specific selection criteria ("A-Z," MA," KA," etc.) is pre-programmed into the display area (27) of the LCD (col. 13, lines 14-25; see FIG. 6 and 7). This configuration is

explicitly disclosed in *Iwata* as necessary to provide a flexible touch-screen device that obviates the need for additional hard-wired buttons (col. 5, lines 22-41). There is no teaching, suggestion or motivation for one having ordinary skill in the art to rely on the touch-screen architecture of *Iwata*'s address book to combine with the disclosure in *Holmstrom*. In order to incorporate the teaching of *Iwata*, the device disclosed in *Holmstrom* would need to be substantially reconfigured to accommodate the features of *Iwata*.

In light of the above remarks, Applicant respectfully submit that claims 9-16 are allowable. Applicants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 112740-372.

In light of the above, Applicant respectfully submits that the rejection under 35 U.S.C. §103 is improper, and Claims 9-16 of the present application are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that the Board overturn the rejection and issue a timely Notice of Allowance in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-372) on the account statement.

Respectfully submitted,  
BELL, BOYD & LLOYD LLC

BY



Peter Zura

Reg. No. 48,196

Customer No.: 24573

Phone: (312) 807-4208

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